



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,331	02/08/2002	Henri Samain	05705.1016	1336

22852 7590 09/10/2003

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
1300 I STREET, NW
WASHINGTON, DC 20005

[REDACTED] EXAMINER

VENKAT, JYOTHSNA A

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

1615

DATE MAILED: 09/10/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary <i>File copy</i>	Application No.	Applicant(s)
	10/019,331	SAMAIN ET AL.
	Examiner JYOTHSNA A VENKAT	Art Unit 1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 June 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 21-52 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 21-52 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Receipt is acknowledged of request for reconsideration filed on 6/23/03. Claims 21-52 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 21-52 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a written description rejection.**

To satisfy the Written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that applicant were in possession of the claimed invention. Applicant's claims are drawn to "*a cosmetic hair composition comprising in a cosmetically acceptable medium, solid particles and at least one adhesive polymer wherein when the composition is dried, the resulting dried material has detachment profile defined by at least one maximum detachment force F_{max} of greater than 1N., wherein F_{max}, as measured by extensometer, is the maximum tensile force needed to detach the surfaces of two respective rigid, inert, nonabsorbent supports (A)and (B) , wherein said surfaces have each have a surface area of 38 mm² and wherein said supports are placed facing each other: and further wherein: said surfaces are precoated at a concentration of 53/c microgrqrams/mm² with a formulation comprising said at least one adhesive polymer in the cosmetically acceptable*

medium, where in c is the concentration of solids in the formulation, expressed in grams per gram of composition ; and said precoated surfaces are dried for 24 hours at 22⁰ C, under a relative humidity of 50%, then subjected for 20 seconds to a compression of 3N, and then subjected to detachment at a speed of 20 mm/minute for 30 seconds to determine F_{max}.

The instant application fails to describe specific examples of adhesive polymers that satisfy the criteria of claims 21-26. The specification describes the adhesive polymer, which satisfies this criterion, at page 4 as AQ 1350 sold by Eastman Kodak. There is no structure given to this polymer except for the trademark name. This polymer has the detachment force F_{max} greater than 1. This is the only polymer described and exemplified. The criteria for the dried material in claim 24 is that the dried material has a glass transition temperature of less than + 10⁰ C. The AQ polymer has a glass transition temperature of 0⁰ C. The functional language recited in the claims without defining the suitable adhesive polymers, does not meet the written description requirement as one of ordinary skill in the art could not recognize or understand the polymers that satisfy the requirement from the mere recitation of the function. Claims employing functional language at the point of novelty, such as applicants', neither provide those elements required to practice the inventions, nor "inform the public" during the life of the patent of the limits of the monopoly asserted. Applicants claimed expression represents only an invitation to experiment regarding possible polymers suitable as adhesive polymers, which can be used in the cosmetic compositions.

Response to Arguments

3. Applicant's arguments filed 6/23/03 have been fully considered but they are not persuasive.

Art Unit: 1615

4. Applicants argue that they have described the invention using words and formulas as permitted, and the present claims provide sufficient detail about the claimed invention without having to disclose a general chemical formula corresponding to particular polymers exhibiting properties that fall within the claims and applicants have described actual reduction to practise the invention in examples 1 and 4 found on pages 11 and 13, where the polymer used in the examples is sold by Eastman Kodak under the trade name "AQ 1350" which has a Tg of 0°C and therefore the claims comply with the written description requirement under 35 U. S. C. 112, first paragraph.

In response to the above argument, it is the position of the examiner that the only polymer described is sold under the trade name. The claims define "adhesive polymer" and one of ordinary skill in the art from reading the specification and naming of one polymer with a trade name could not recognize or understand the polymers that satisfy the requirement from the mere recitation of the function. The claims recite the functional language and **it does not inform the public" during the life of the patent of the limits of the monopoly asserted.** Applicants claimed expression represents only an invitation to experiment regarding possible polymers suitable as adhesive polymers, which can be used in the cosmetic compositions satisfying all the criteria .

5. Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection..**

6. There is no support in the specification for "ketones, alkyl acetates, and di-alkoxy substituted alkanes". the specification describes at page 10, 2nd paragraph two compounds under ketones, which are acetone and methyl ethyl ketone. The same is true for acetates and di-alkoxy substituted alkanes. Description for two specific compounds in each category is not a support for the entire genus.

Response to Arguments

7. Applicant's arguments filed 6/23/03 have been fully considered but they are not persuasive.
8. The gist of applicant's arguments is that the recitation of at least two species contained within each genus constitutes a sufficient number of species to describe the entire genus.
9. In response to the above argument, the expression "claimed" is outside the scope of the description in the specification (emphasis added) and therefore the claimed expression is new matter.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 21-38, and 42 are, rejected under 35 U.S.C. 102(b) as being anticipated by U. S. patent 5,053,221 ('221).

12. The claims are drawn to compositions and claims recite the functional language which is

when the composition is dried, the resulting dried material has detachment profile defined by at least one maximum detachment force F_{max} of greater than 1N., wherein F_{max} , as measured by extensometer, is the maximum tensile force needed to detach the surfaces of two respective rigid, inert, nonabsorbent supports (A)and (B) , wherein said surfaces have each have a surface area of

38 mm² and wherein said supports are placed facing each other: and further wherein:

said surfaces are precoated at a concentration of 53/c micrograms/mm² with a formulation comprising said at least one adhesive polymer in the cosmetically acceptable medium, where in c is the concentration of solids in the formulation, expressed in grams per gram of composition ; and

said precoated surfaces are dried for 24 hours at 22⁰ C, under a relative humidity of 50%, then subjected for 20 seconds to a compression of 3N, and then subjected to detachment at a speed of 20 mm/minute for 30 seconds to determine F_{max} .

The office is not equipped to manufacture the composition and then drying the composition so that it satisfies the functional criteria of claims 21-26. Therefore the claims are anticipated, absence of evidence to the contrary.

See col.2, lines 30-45 for the beads which read on the claimed particles. There is overlap of concentration and particle size. See the paragraph bridging col.s 3-4 for the adhesive polymer and see col.4, lines 18 et seq and col.5, lines 1-60 for the AQ polymers. The polymer disclosed in the patent reads on the claimed adhesive polymer. See the examples for ethanol which read on the solvent, see col5, lines 60 et seq and col.6 for the additives.

Response to Arguments

13. Applicant's arguments filed 6/23/03 have been fully considered but they are not persuasive.

Applicants argue that the patent does not contain any discussion indicating that it's disclosed compositions would exhibit presently claimed detachment profile and the polymers disclosed in the patent have among other things different Tg and hydroxyl content.

In response to the above argument, it is the position of the examiner that applicants did not present any evidence that all the AQ polymers described in the patent are distinct from the "adhesive polymer" claimed broadly (emphasis added). Since the polymer is the same the detachment profile is inherent.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-

2439. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


JAYOTH SNA A VENKAT
Primary Examiner
Art Unit 1615
